

Remarks

Subsequent to the amendments made herein, claims 14, 16, 17, and 25 are pending. The remaining claims have been canceled without prejudice.

Claim Rejections 35 U.S.C. §102

The Action rejects claims 11-13 as being anticipated by Ikeda (JP 4-332406). Applicant has canceled claims 11-13, thus, the rejection to these claims is now moot.

Claim Rejections 35 U.S.C. §103

The Action rejects claims 1, 14-17, 19-20, 22-23, and 25-26 as being unpatentable over Ikeda in further view of Arroyo (U.S. 4,807,962). According to the Action, Arroyo teaches that the configuration of its fluted member provides strength for the cable as well as the compartments and is relatively inexpensive. Therefore, according to the Action, one would modify the shape of the fluted member of Ikeda to follow that of Arroyo. In order to support its asserted modifications, the Action must base its assertion on an examination of the references as a whole rather than utilizing bits and pieces apart from their teachings. See *Bausch & Lomb, Inc. v. Barnes-Hind Hydro Curve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986) cert. Denied. 484 U.S. 823 (1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d (Fed. Cir. 1985). Any modifications necessary to the prior art to produce the claimed invention must be suggested by the prior art. See *In Re: Gordon*, 733 F.2d (Fed. Cir. 1994). See also *In Re: Miskarsky*, 871 F.2d 1115 (1989). Modifying the Ikeda fluted member to follow the shape in Arroyo does not follow from the teachings as a whole. In fact, the modification directly contradicts the teachings of Ikeda. Moreover, Arroyo does not suggest that its fluted member has a shape which provides strength which would improve Ikeda. Therefore one would not modify Ikeda so as to have open areas that have volumes equal to or greater than the volumes of the adjacent projections forming the

open areas. See Applicant's amended claim 14. Additionally, one would not modify Ikeda to have an unshielded fluted member. See claims.

Ikeda has as its object to provide a spacer which is excellent in flexibility and shielding. See translation, page 2, last full paragraph. To provide for the shielding, the spacer is coated with conductive resin 6. The complete shielding of the conductors disposed in the grooved spacer is obtained by providing a holding tape around the outside of the spacer and crushing the rubber-like elastic body. See page 5 of the translation, second to last full paragraph. The Ikeda shape thus, upon crushing, provides a shielded envelope around the conductors. The shape is therefore instrumental. The shape of the Arroyo spacer does not allow for the crushing and resulting capsulation as mandated by Ikeda. Thus a skilled artisan looking to improve Ikeda would not adopt the shape of Arroyo, the shape completely destroys the purpose of Ikeda.

The mere fact that the elements of Applicant's invention may be found in the prior art has no relevance. "Most if not all inventions arise from a combination of old elements.... thus, every element of a claimed invention may often be found in the prior art. To establish obviousness... there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicant." See in re: *Kotsab*, 217 F.3d 1365 (Fed. Cir. 2000). Arroyo simply does not teach modifying the elements of Ikeda. Its shape has no relevance and in fact contradicts the purposes of Ikeda. Thus, claim 14 is allowable over Ikeda in view of Arroyo. The remaining claims, dependent on claim 14 are thus also themselves allowable.

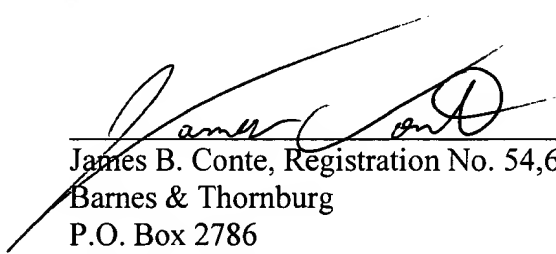
Further, claim 25 has additional allowable features. Claim 25 calls for an unshielded plastic support. Ikeda specifically discloses using a shielded support. Ikeda requires the shielding to effect its purpose, individually shielding the twisting pairs. Thus, someone following in the teachings of Ikeda, even in view of Arroyo, would at least use shielding. Thus,

claim 25 is allowable for this additional reason.

Conclusion

Applicant has complied with the requirements of the Action. Each of the pending claims stands in allowable condition. A Notice of Allowance should now issue.

Respectfully submitted,



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